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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,596	11/02/2004	Reinhard Treiber	260777US0PCT	5698

22850 7590 09/25/2006

C. IRVIN MCCLELLAND
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/511,596

Applicant(s)

TREIBER ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/14/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 23 is/are rejected.
- 7) ☒ Claim(s) 22 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The amendment of 6/14/06 has been entered. Claims 1-24 are pending.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11, 13-21, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4147679 Scriven et al..

Scriven discloses the instantly claimed aqueous polyurethanes, coating methods, and coated substrates at the abstract; column 3, lines 24-55 and 58-68; column 4, lines 1-68, particularly 25-68; column 5, lines 1-68, particularly 1-4 and 67-68; column 6, lines 1-68, particularly 12-32 which encompasses the instantly claimed isocyanates and amounts thereof of the instant claims 1-3; column 7, lines 1-68; column 8, lines 1-68, particularly 10-68 which encompasses the instantly claimed components c through e; column 9, lines 1-68; column 10, lines 1-68; column 11, lines 1-68, particularly 1-7; column 12, lines 1-68; column 13, lines 1-68; column 14, lines 1-68, particularly 38-43 which falls within the scope of the instant claim 11; column 15, lines 1-68, particularly 21-68 which encompasses the instantly claimed amounts of components c and d; column 16, lines 1-68, particularly 1-11, 26-37, which encompasses the instantly claimed amounts of component e, and 49-68; column 17, lines 1-68, particularly 23-55; column 18, lines

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1-68, particularly 3-15, which encompasses the instantly claimed particle sizes and 45-68; column 19, lines 1-68, particularly 19-68 which falls within the scope of the instantly claimed components f and g; column 20, lines 1-68, particularly 14-28; column 23, lines 25-36 which encompasses the instantly claimed coating methods and coated substrates; column 24, lines 35-68 which encompasses the instantly claimed reactant amounts as does column 25, lines 1-68; column 26, lines 1-68 and the remaining examples; and the remainder of the document. Column 30, line 32-33 falls within the scope of the instant claim 10.

Preferred modes of the patentee's polyurethane particle sizes are within those of the instant claims. The endpoints specified at column 18, lines 3-10 are specified sufficiently so as to anticipate the instantly claimed particle sizes. The physical parameters argued by the applicant are materially affected by many factors other than the instantly claimed broad monomer ranges, such as but not limited to additive types and amounts, the nature of the monomers themselves, which are claimed very broadly and many other factors understood by the ordinary skilled artisan. Most of the instant claims do not require matting, etc. argued by the applicant. The claims which do not recite "matte" also do not exclude glossy coatings. Preferred mode does not teach away from the other disclosures of the patentee and the applicant has not shown the disclosure of the patentee to not encompass the instantly claimed monomer amounts nor that these monomer amounts alone give an unexpected result over the compositions of Scriven in a manner commensurate in scope with the disclosure of Scriven and the instant claims. It is not seen that the patentee's coatings are limited to glossy coatings nor hard coatings as the abstract clearly states that the coatings disclosed can have a wide variety of properties. It is when they are added to other compositions that hardness is improved as is flexibility. These are opposite

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properties. Column 29 is not representative of the entirety of the teachings of the patentee.

Based on the applicant's arguments relating particle size to matting, it is expected that where the particles of the patentee have the instantly claimed particle sizes and monomer contents that they will also be matte, which falls within the scope of the new claims 21 and 23.

4. Claims 1-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4147679 Scriven et al..

Scriven discloses the instantly claimed aqueous polyurethanes, coating methods, and coated substrates at the abstract; column 3, lines 24-55 and 58-68; column 4, lines 1-68, particularly 25-68; column 5, lines 1-68, particularly 1-4 and 67-68; column 6, lines 1-68, particularly 12-32 which encompasses the instantly claimed isocyanates and amounts thereof of the instant claims 1-3; column 7, lines 1-68; column 8, lines 1-68, particularly 10-68 which encompasses the instantly claimed components c through e; column 9, lines 1-68; column 10, lines 1-68; column 11, lines 1-68, particularly 1-7; column 12, lines 1-68; column 13, lines 1-68; column 14, lines 1-68, particularly 38-43 which falls within the scope of the instant claim 11; column 15, lines 1-68, particularly 21-68 which encompasses the instantly claimed amounts of components c and d; column 16, lines 1-68, particularly 1-11, 26-37, which encompasses the instantly claimed amounts of component e, and 49-68; column 17, lines 1-68, particularly 23-55; column 18, lines 1-68, particularly 3-15, which encompasses the instantly claimed particle sizes and 45-68; column 19, lines 1-68, particularly 19-68 which falls within the scope of the instantly claimed components f and g; column 20, lines 1-68, particularly 14-28; column 23, lines 25-36 which encompasses the instantly claimed coating methods and coated substrates; column 24, lines 35-68 which encompasses the instantly claimed reactant amounts as does column 25, lines 1-68;

column 26, lines 1-68 and the remaining examples; and the remainder of the document. Column 30, line 32-33 falls within the scope of the instant claim 10.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed ingredient combinations and amounts thereof because they are encompassed by the patentee and would have been expected to give coatings having the properties described by the patentee.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed cesium salt of claim 12 because Scriven discloses the use of catalysts generally and cesium salts are well known to catalyze the urethane reaction as shown by Endo, abstract; column 3, lines 3-6 and the remainder of the document and Murphy, column 1, lines 55-72; column 2, lines 60-72; column 4, lines 46-47 and 59.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed amine of claim 8 because cyclic amines are encompassed as the chain extenders of Scriven and isophorone diamine is a well known urethane chain extender as taught by Scriven (729) column 6, lines 61-68; column 7, lines 1-6 of which isophorone diamine is that of the instant claim 8, which would give its known properties to the final urethane of Scriven (679).

Preferred modes of the patentee's polyurethane particle sizes are within those of the instant claims. The endpoints specified at column 18, lines 3-10 are specified sufficiently so as to anticipate the instantly claimed particle sizes. The physical parameters argued by the applicant are materially affected by many factors other than the instantly claimed broad monomer ranges, such as but not limited to additive types and amounts, the nature of the monomers themselves,

which are claimed very broadly and many other factors understood by the ordinary skilled artisan. Most of the instant claims do not require matting, etc. argued by the applicant. The claims which do not recite “matte” also do not exclude glossy coatings. Preferred mode does not teach away from the other disclosures of the patentee and the applicant has not shown the disclosure of the patentee to not encompass the instantly claimed monomer amounts nor that these monomer amounts alone give an unexpected result over the compositions of Scriven in a manner commensurate in scope with the disclosure of Scriven and the instant claims. It is not seen that the patentee’s coatings are limited to glossy coatings nor hard coatings as the abstract clearly states that the coatings disclosed can have a wide variety of properties. It is when they are added to other compositions that hardness is improved as is flexibility. These are opposite properties. Column 29 is not representative of the entirety of the teachings of the patentee. Based on the applicant’s arguments relating particle size to matting, it is expected that where the particles of the patentee have the instantly claimed particle sizes and monomer contents that they will also be matte, which falls within the scope of the new claims 21 and 23.

5. Claims 22 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art does not disclose matted/matting leather with the instantly claimed compositions nor provide proper rationale for doing so.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

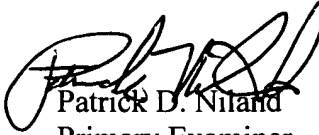
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Patrick D. Niland
Primary Examiner
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